



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

ch

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/644,241      | 08/20/2003  | Dewey H. Scruggs JR. |                     | 6063             |

7590 08/12/2004  
DEWEY H. SCRUGGS JR.  
5351 VISTA GLEN  
SAN ANTONIO, TX 78247

EXAMINER

HUNTER, ALVIN A

ART UNIT PAPER NUMBER

3711

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |   |  |
|------------------------------|-----------------|---|--|
| <b>Office Action Summary</b> | Application No. | Applicant(s)  |  |
|                              | 10/644,241      | SCRUGGS, DEWEY H. <span style="float: right;">ON</span> |  |
|                              | Examiner        | Art Unit  |  |
|                              | Alvin A. Hunter | 3711  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2003.  
 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-10 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/20/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

L

## **DETAILED ACTION**

### ***Priority***

1. Applicant makes reference to provisional application 60/216456. Priority fails to comply with 35 USC 119(e). In order to claim benefit of a provisional application, the non-provisional application must be filed no later than 12 months after the filing of the provisional application.

### ***Specification***

2. The abstract of the disclosure is objected to because abstract is longer than 150 words and is on more than one page. Correction is required. See MPEP § 608.01(b).

### ***Claim Objections***

3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims A-J have been renumbered 1-10.***Claim Rejections - 35***

### ***USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-10 are rejected as failing to define the invention in the manner required by 35 U.S.C. 112, second paragraph.

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device must be clearly and positively specified. The structure must be organized and correlated in such a manner as to present a complete operative device. The claim(s) must be in one sentence form only. Note the format of the claims in the patent(s) cited.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 5, and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Bagley (USPN 5417421).

Regarding claim 1, Bagley discloses a method of table hockey that offers a close resemblance and action to the sport of ice/roller hockey (See Abstract).

Regarding claim 2, Bagley discloses the number of player being 2 players (See Abstract).

Regarding claim 3, Bagley discloses a divider 29 for breaking playing area into separate fields of play (See Column 3, lines 3 through 11).

Regarding claim 5, Bagley discloses the game providing one-on-one competition between the same players (See Abstract).

Regarding claim 7, Bagley discloses operational procedures for the invention (See entire disclosure).

Regarding claim 8, Bagley discloses the players using sticks (See Figure 10).

Regarding claim 9, Bagley discloses rules for officiating the game (See Entire disclosure).

6. Claims 1-4, 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Shiledar Baxi (USPN 5556094).

Regarding claim 1, Shiledar Baxi discloses a method of table hockey that offers a close resemblance and action to the sport of ice/roller hockey (See Column 4, lines 27 through 41).

Regarding claim 2, Shiledar Baxi discloses the number of player being up to 6 players (See Column 4, lines 27 through 41).

Regarding claim 3, Shiledar Baxi discloses a divider for breaking playing area into separate fields of play (See Figure 1).

Regarding claim 4, Shiledar Baxi shows a pass through provided for movement of the puck between fields (See Figure 1).

Regarding claim 7, Shiledar Baxi discloses operational procedures for the invention (See Column 4, lines 27 through 41).

Regarding claim 8, Shiledar Baxi discloses the players using sticks (See Column 4, lines 27 through 41).

Regarding claim 9, Shiledar Baxi discloses rules for officiating the game (See Column 4, lines 27 through 41).

Regarding claim 10, Shiledar Baxi discloses penalties to be applied when infraction s of the rules occur (See Column 4, lines 27 through 41).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shiledar Baxi (USPN 5556094).

Regarding claim 6, Shiledar Baxi discloses the playing area bearing indicia for identifying areas of the fields. Shiledar Baxi performs the same function of that claimed by the applicant. Applicant has not disclosed why it is critical to only use alpha numeric numbering to identify specific areas, therefore, one having ordinary skill in the art would have found such to be an obvious matter of design choice.

***Conclusion***

An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent.

Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication

is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is 703-306-5693. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAH  
Alvin A. Hunter, Jr.

  
GREGORY VIDOVICH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700